



AF/JFw

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Application No. 10/801,309

Applicant: William E. Italia

Filed: March 16, 2004

TC/AU: 2617

Examiner: HOLLIDAY, JAMIE MICHELE

Docket No.: 252274 (Client Reference No. GP-304136)

Customer No.: 73811

APPELLANTS' APPEAL BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In support of the appeal from the final rejection dated February 21, 2008,
Appellants now submit their Brief.

Real Party In Interest

The patent application that is the subject of this appeal is assigned to General Motors
Corporation.

Related Appeals and Interferences

There are no appeals or interferences that are related to this appeal.

Status of Claims

Claims 1-15 are pending and are rejected. Claims 16-20 were cancelled. Claims 1-5
and 7-15 are rejected under 35 U.S.C. §102 and claim 6 is rejected under §103. Claims 1-15
are appealed.

09/22/2008 MBLANCO 00000016 070960 10801309
01 FC:1402 510.00 DA
02 FC:1251 120.00 DA

4. Extension of Time

Appellants petition for a one-month extension of time under 37 CFR 1.136, the fee for which is \$120.00.

Appellants believe that no extension of time is required. However, this conditional petition is being made to provide for the possibility that appellants have inadvertently overlooked the need for a petition and fee for extension of time.

Extension fee due with this request: \$120.00

5. Total Fee Due

The total fee due is:

Brief on Appeal Fee	\$510.00
Less Brief on Appeal Fee already paid	
Request for Oral Hearing	\$ 0.00
Extension Fee (if any)	\$120.00
Total Fee Due: 630.00	

6. Fee Payment

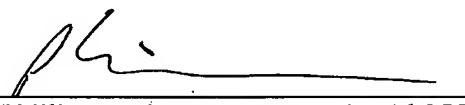
Attached is a check in the sum of \$

Charge Account No. 07-0960 the sum of \$630. A duplicate of this transmittal is attached.

7. Fee Deficiency

If any additional fee is required in connection with this communication, charge Account No. 07-0960. A duplicate copy of this transmittal is attached.

Respectfully submitted,

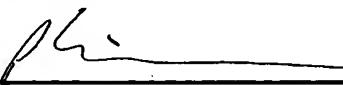


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Date: September 15, 2008

CERTIFICATE OF MAILING OR TRANSMISSION UNDER 37 CFR 1.8

I hereby certify that this Document and all accompanying documents are, on the date indicated below, being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Brief – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, or being facsimile transmitted to the U.S. Patent and Trademark Office, Facsimile Number (571) 273-8300.

<i>Name (Print/Type)</i>	Phillip M. Pippenger		
<i>Signature</i>		<i>Date</i>	September 15, 2008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application No. 10/801,309

Confirmation No. 1978

Applicant: William E. Italia

Filed: March 16, 2004

TC/AU: 2617

Examiner: HOLLIDAY, JAMIE MICHELE.

Docket No.: 252274 (Client Reference No. GP-304136)

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TRANSMITTAL OF APPELLANTS' BRIEF ON APPEAL

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In accordance with 37 CFR 41.37, Appellant(s) hereby submit Appellants' Brief on Appeal.

The items checked below are appropriate:

1. Status of Appellant(s)

This application is on behalf of other than a small entity or a small entity.

2. Fee for Filing Brief on Appeal

Pursuant to 37 CFR 41.20(2), the fee for filing the Brief on Appeal is for:

other than a small entity or a small entity.

3. Oral Hearing

Brief Fee Due \$510.00

Appellant(s) request(s) an oral hearing in accordance with 37 CFR 41.47.

A separate paper requesting oral hearing is attached.

4. Extension of Time

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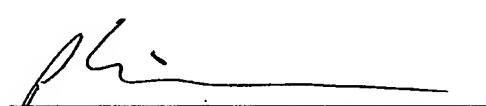
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Name (Print/Type)	Phillip M. Pippenger		
Signature		Date	September 15, 2008



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3. Oral Hearing

Appellant(s) request(s) an oral hearing in accordance with 37 CFR 41.47.

A separate paper requesting oral hearing is attached.

Status of Amendments

There are no amendments after final pending.

Summary of Claimed Subject Matter

Independent claim 1 pertains to a method for assigning a mobile dialing number to a wireless mobile communication device to give local call access to the mobile communication device from its base address. The method includes, in pertinent detail, first selecting a wireless rate center that (1) encompasses the base address and (2) has a mobile dialing number providing local call access from the base address. *See* Fig. 4, steps 26-28, and Specification at page 10, lines 23-28. After such mobile dialing number is identified, it is assigned to the mobile communication device. *See* Fig. 4, steps 30-34, and Specification at page 11, lines 1-15.

Independent claim 11 is expressly written in means-plus-function format to invoke 35 U.S.C. §112, paragraph 6. This claim pertains to an apparatus for assigning a mobile dialing number to a wireless mobile communication device to give local call access to the mobile communication device from its base address. The apparatus includes, in pertinent detail, means for selecting a wireless rate center that (1) encompasses the base address and (2) has a mobile dialing number providing local call access from the base address. *See* Fig. 4, steps 26-28, and Specification at page 10, lines 23-28. The means is the Mobile Communication System (MCS) or its equivalent programmed or operated so as to execute exactly the identified steps (and no equivalents). The apparatus further includes means for assigning the mobile dialing number to the mobile communication device. *See* Fig. 4, steps 30-34, and Specification at page 11, lines 1-15. The means in this case is the Wireless Service Provider (WSP) or its equivalent programmed or operated so as to execute exactly the identified steps (and no equivalents).

Grounds of Rejection to be reviewed on Appeal

Claims 1-15 are pending and are rejected. Claims 1-15 are appealed. Claims 1-5 and 7-15 are rejected under 35 U.S.C. §102, which rejections are appealed. Claim 6 is rejected under §103, but this rejection would be mooted by a favorable reconsideration of the §102 rejections.

*Argument*Claims 1-10

The first assertion of the "Response" section of the Action is that the elements relied upon for patentability are missing from the claims. In particular, the Action stated as follows:

2. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., assigning the local dialing number to the mobile device) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification,

However, there seems to be some misunderstanding -- the argued distinction is expressly recited in all of the claims. Applicants respectfully draw the Office's attention to independent claim 1.

Claim 1: "... *assigning the MDN providing local calling access to the MCD*".

In short, the claims very clearly recite *verbatim* the very distinction that the Examiner alleges to be missing.

The Action then asserts that the Howe reference nonetheless *does* teach a step of assigning a local number to a mobile unit. Again, there appears to be some misunderstanding, because this assertion is simply and plainly false. The Action asserts the following in this regard (see the Final Action, pp. 2-3):

Since the mobile terminal is
associated with the MIN of the data unit, which is connected to the mobile terminal and
has phone capabilities, the assigned TLDN to the data unit will be used to route the call to
the mobile phone.

This statement is conclusive, and worse yet, the conclusion does not relate to the claimed invention. It is irrelevant that the assigned TLDN is "used to route" the call to the mobile phone. The fact that a particular number is used for routing somewhere in the transmission process doesn't change the mobile phone's number – otherwise, the mobile phone would have a different number every time it received a call, hardly a logical conclusion. Rather,

Howe's data unit calls Howe's mobile unit via the **mobile unit's** own assigned number -- not, of course, the **data unit's** (local) number.

Based on the Office Actions, the Examiner does not disagree with the above. Rather, the Examiner apparently feels that assigning a local number to a stationary data unit is the same as assigning a local number to a mobile unit since the mobile unit and data unit could be "associated" with one another during use. However, this yet again evidences a failure to comprehend the claims and the art; the claims don't pertain to assigning a number to a piece of equipment that may be momentarily in communication *with* the mobile device -- the claims call for assigning a particular number *to the mobile device itself*. That is exactly what Howe fails to teach. Please reverse the pending rejections.

Claims 11-15

The above remarks regarding claims 1-10 are applicable to claims 11-15, and are herein repeated and incorporated by reference. Moreover, claims 11-15 are clearly written in means-plus-function format to invoke 35 U.S.C. §112, paragraph 6. Because the claims have not been treated under §112 paragraph 6, e.g., in the manner prescribed at MPEP §2181, *a prima facie case of unpatentability was never presented by the Examiner during prosecution*. For this additional reason, allowance of claims 11-15 at this point is requested.

Respectfully submitted,



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Date: September 15, 2008

Claims Appendix

1. (Original) A method for assigning a mobile dialing number(MDN) to a wireless mobile communication device (MCD) for providing local call access to the MCD from a base address for the MCD, the method comprising:

selecting a wireless rate center encompassing the base address and having an MDN providing local call access to the MCD from the base address for the MCD; and

assigning the MDN providing local calling access to the MCD from the base address for the MCD, in the selected wireless rate center encompassing the base address, to the MCD.

2. (Original) The method of claim 1, further comprising, activating the assigned MDN.

3. (Original) The method of claim 2, further comprising, configuring the MCD for operation with the assigned MDN.

4. (Original) The method of claim 1, further comprising:

compiling a database defining geographic boundaries of a plurality of wireless rate centers; and

selecting the wireless rate center of claim 1 from the database.

5. (Original) The method of claim 4, further comprising, converting the base address to a geographic location and selecting the wireless rate center from those wireless rate centers in the database having geographic boundaries encompassing the geographic location of the base address.

6. (Previously Presented) The method of claim 5, further comprising, defining the geographic boundaries of the wireless rate centers and the geographic location of the base address in terms of latitude and longitude.

7. (Original) The method of claim 1 further comprising:

selecting the wireless rate center prior to contacting a wireless service provider, and

transmitting a designation of the selected wireless rate center to a wireless service provider for assignment of the MDN by the wireless service provider.

8. (Previously Presented) The method of claim 7, further comprising assigning the MDN and transmitting the assigned MDN to an entity other than the wireless service provider for configuring the MCD for operation with the assigned MDN.

9. (Previously Presented) The method of claim 7, further comprising transmitting a serial number of the MCD to the wireless service provider together with the designation of the selected wireless rate center.

10. (Previously Presented) The method of claim 9, further comprising assigning the MDN and transmitting the serial number, together with the assigned MDN, to an entity other than the wireless service provider for configuring the MCD for operation with the assigned MDN.

11. (Original) An apparatus for assigning a mobile dialing number combination (MDN) to a wireless mobile communication device (MCD) for providing local call access to the MCD from a base address for the MCD, the apparatus comprising:

means for selecting a wireless rate center encompassing the base address and having an MDN providing local call access to the MCD from the base address for the MCD; and

means for assigning the MDN providing local calling access to the MCD from the base address for the MCD, in the selected wireless rate center encompassing the base address, to the MCD.

12. (Previously Presented) The apparatus of claim 11, further comprising:
 - a database defining geographic boundaries of a plurality of wireless rate centers; and
 - means for selecting the wireless rate center from the database.
13. (Original) The apparatus of claim 12, further comprising, means for converting the base address to a geographic location and selecting the wireless rate center from those wireless rate centers in the database having geographic boundaries encompassing the geographic location of the base address.
14. (Original) The apparatus of claim 11, further comprising:
 - means for selecting the wireless rate center prior to contacting a wireless service provider; and
 - means for transmitting a designation of the selected wireless rate center to a wireless service provider for assignment of the MDN by the wireless service provider.
15. (Previously Presented) The apparatus of claim 11, further comprising, means for assigning the MDN and transmitting the assigned MDN to an entity other than the wireless service provider for configuring the MCD for operation with the assigned MDN.
16. (Cancelled)
17. (Cancelled)
18. (Cancelled)
19. (Cancelled)
20. (Cancelled)

Evidence Appendix

NONE

Related Proceedings Appendix

NONE